

O-594-15

TRADE MARKS ACT 1994

IN THE MATTER OF

INTERNATIONAL REGISTRATION NO. 1217585

IN THE NAME OF

SCA HYGIENE PRODUCTS AB

TO REGISTER:

INSTADRY

IN CLASS 5

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 403520 BY THE PROCTER & GAMBLE COMPANY

BACKGROUND

1. On 18 June 2014, SCA Hygiene Products AB (“the applicant”) requested protection in the United Kingdom for the International Registration (“IR”) of the trade mark shown on the cover page of this decision. The United Kingdom Trade Marks Registry (“TMR”) considered the request satisfied the requirements for protection and particulars of the IR were published on 10 October 2014 for the following goods in class 5:

Class 5 - Sanitary napkins (towels); sanitary panties; sanitary knickers; panty liners (sanitary); napkins for incontinence; absorbent pants and panties for incontinence; tissues impregnated with pharmaceutical lotions (for medical purposes); diapers for incontinence (for medical purposes); fixation pants for use by persons suffering from incontinence (for medical purposes); disposable diapers and diaper pants made of paper and/or cellulose.

2. The designation of the IR is opposed by The Procter & Gamble Company (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition, which is directed against all of the goods in the IR, is based upon the goods (shown below) in the following Community Trade Mark (“CTM”):

CTM no. 8214471 for the trade mark: InstantDry, the application for which was filed on 14 April 2009 and the registration procedure for which was completed on 10 September 2009:

Class 5 - Feminine hygiene products, such as sanitary napkins, tampons, panty liners, sanitary briefs, interlabial pads for feminine hygiene.

3. The applicant filed a counterstatement in which the basis of the opposition is denied.

4. Whilst only the opponent filed evidence, the applicant filed written submissions during the course of the evidence rounds. Although neither party asked to be heard, the opponent filed written submissions in lieu of attendance at a hearing; I will, where necessary, refer to these various submissions below.

5. On 7 October 2015, the applicant sought to restrict its specification of goods by filing Form MM6(E) with the International Bureau. The revised specification is as follows:

Napkins for incontinence; absorbent pants and panties for incontinence; diapers for incontinence (for medical purposes); fixation pants for use by persons suffering from incontinence (for medical purposes).

At the time of writing, the administrative process relating to the above Form was still pending. The TMR will need to bear this in mind before this decision is implemented.

The opponent's evidence

6. This consists of a witness statement from Christina Turner, the opponent's Brand Manager, Always & Tampax, a position she has held since December 2011. Having provided some background to the opponent's history and business, Ms Turner states:

“3...The InstantDry trade mark was first used in Europe including United Kingdom in January 2010. It has been used across Europe since this time in connection with [the goods shown in paragraph 2].”

7. Exhibit 1 to Ms Turner's statement consists of 42 screen shots which Ms Turner states are:

“4...examples of use of the InstantDry trade mark in the trade over the period October 2009 to October 2014 in relation to [the goods shown in paragraph 2] as well as very recent examples of use of the InstantDry trade mark dated from 2015 in the trade and on our corporate websites in relation to [the goods shown in paragraph 2] across Europe that illustrate the wide use of this trade mark across our range of feminine hygiene products.”

8. Ms Turner further states:

“5...we have very often used the TM symbol along with the InstantDry trade mark, this being a clear indication to the public that the sign is used as a trade mark with the aim to distinguish the marked products from those of other companies.”

9. I will return to this evidence later in this decision.

DECISION

10. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

“5 (2) A trade mark shall not be registered if because -

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

12. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. However, as this trade mark completed its registration process more than 5 years before the publication date of the IR in suit, it is, in principle, subject to proof of use, as per section 6A of the Act. In its Notice of Opposition the opponent states that it has used its earlier trade mark in relation to all the goods upon which it relies, and in its counterstatement, the applicant puts the opponent to proof of this claim. The relevant sections of the Act read as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Section 100 of the Act is also relevant and reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Proof of use

13. In reaching a conclusion, I must apply the same factors as I would if I were determining an application for revocation of a trade mark registration based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of the publication of the IR i.e. 11 October 2009 to 10 October 2014. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the Court of Justice of the European Union (“CJEU”) in relation to genuine use of a trade mark:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeo SRL v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at

[42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or

services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

14. Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 *P, Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

15. As the earlier right upon which the opponent relies is a CTM, the comments in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are relevant. In that case the CJEU noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A de minimis rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by

analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)."

The court held that:

"Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."

16. in reaching a conclusion, I shall keep in mind the comments of the Appointed Person in *Awareness Limited v Plymouth City Council*, (BL O/230/13), in which Mr Daniel Alexander Q.C. stated that:

"22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

and further at paragraph 28:

"28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as "tuition services", is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to "tuition services" even by compendious reference to the trade

mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

17. The comments in *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd* (BL O/404/13) are also relevant, in which Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, stated:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. V. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

18. In considering the opponent’s evidence, it is a matter of viewing the picture as a whole, including whether individual exhibits corroborate each other. In Case T-415/09, *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, in relation to the need to get a sense

from the overall picture of the evidence, notwithstanding that individual pieces may not, of themselves, be compelling, the General Court (“GC”) stated:

“53. In order to examine whether use of an earlier mark is genuine, an overall assessment must be carried out which takes account of all the relevant factors in the particular case. Genuine use of a trade mark, it is true, cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (COLORIS, paragraph 24). However, it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (see, to that effect, judgment of the Court of Justice of 17 April 2008 in Case C-108/07 P Ferrero Deutschland v OHIM, not published in the ECR, paragraph 36).”

19. In their written submissions, the opponent makes the following points:

“9...The use has been shown particularly in relation to sanitary towels, pads and napkins...”

It is acknowledged that other trade marks also appear in connection with the goods, such as ALWAYS...

The use of InstantDry shown quite clearly shows the mark InstantDry has its own independent character as a mark and serves to indicate origin. Minimum use can of course qualify as genuine use...The evidence filed is not mere token use and shows that the opponent was maintaining an outlet for the goods on the relevant market.”

20. In their written submissions, the applicant makes the following points:

“the pictures of the products on the screenshots show that the products generally do not appear to be marked with the sign InstantDry. Furthermore, contrary to the opponent’s assertions, the TM symbol has NOT very often been used along with the sign InstantDry. At least 25 of the 42 screenshots show “InstantDry” (or variations thereof such as Instant Dry or Instant dry) WITHOUT the TM symbol. Furthermore, many of the remaining screenshots refer to “an InstantDry Effect”, the TM symbol occasionally being positioned after the word “Effect”. These inconsistencies do not make it appear that the sign InstantDry has been used in a manner which could give the public a clear indication that the sign is being used as a trade mark with the aim of distinguishing products from those of other companies, and hence InstantDry does not appear to be used in a trade mark sense.

Notwithstanding the above, the evidence shows that the opponent has not used the mark in respect of all of the goods in the specification...Any use which might

have been made of the mark is confined solely to sanitary napkins for feminine hygiene."

21. Pages 1 to 19 of exhibit 1 date from 11 December 2010 to 25 September 2014 i.e. they are all within the relevant period. They consist of screen shots obtained using the Internet Archive waybackmachine. They are from the opponent's own corporate websites as well as from various third party websites; the extracts are from the Benelux, the United Kingdom, Ireland, France and Germany. As the applicant points out, the manner in which the trade mark upon which the opponent relies is presented varies. In all of the screen shots provided, it is, I think, fair to say, that it is the word "always" which is the primary indicator of origin. This word is, for the most part, accompanied by a secondary indication such as "ultra" and "Maxi". An analysis of the various screenshots reveals the following results:

- Pages 1 and 2 are from the same third party website directed at, I think, the Benelux market, page 13 is from a third party website directed at the Irish market; they all bear "InstantDry" accompanied by the letters TM presented in either superscript i.e. TM or in upper case;
- Page 3 is from a third party website directed at the United Kingdom market; it bears the following: "5. InstantDry EffectTM – So you feel dry in an instant";
- Pages 4, 5, 6 and 7 are from the opponent's United Kingdom corporate website and bear the following: "Instant Dry";
- Pages 8, 9 and 10 are from the same third party website directed at the United Kingdom market; they bear the following: "InstantDry + Secureguard + Super Fit + Cotton-like feeling" (pages 8 and 10) and "InstantDry + Secureguard + Super Fit + Super Absorbent + Cotton-like feeling + Extra Night coverage" (page 9);
- Pages 11, 12 and 19 are from the same third party website as page 13 and contain the following: "Instant Dry effect to help you feel dry in an instant" (page 11), "New InstantDry Effect So you feel dry in an instant" (page 12) and "InstantDry Effect so you feel dry in an instant" (page 19);
- Page 14 is from the opponent's French Corporate website; it bears the following: "Instant DryTM";
- Pages 15 and 17 are from the same third party website directed at the French market; they contain the following: "InstantDry";
- Page 16 is from a third party website directed at the United Kingdom market, it contains the following "...InstantDry Effect – so you feel dry in an instant";
- Page 18 is from a third party website directed at the German market; it contains the following entry: "InstantDry";

22. Pages 20 to 42 are from 2015 i.e. after the relevant period. They comprise extracts from the opponent's corporate websites in the United Kingdom, France, Finland, Denmark, Sweden and Germany (pages 20 to 25) and from third party websites in the Benelux (pages 26 to 28), France (page 29), the United Kingdom (pages 30 to 35), Ireland (pages 36 and 37), Sweden (pages 38 to 40) and Germany (pages 41 and 42). The pages bear the following:

- “Instant Dry” (page 20);
- “Instant Dry™” (page 21);
- “InstantDry™” (pages 22 to 24);
- “InstantDry Effect™” (page 25);
- “Instant dry – Always”, “ALWAYS INSTANT DRY” and “Instant Dry de Always” (page 26);
- “InstantDry effect” (page 27);
- “InstantDry(TM) effect” and “InstantDry™ effect” (page 28);
- “InstantDry” (page 29);
- “including a new instant dry effect...” (page 30);
- “Instant Dry effect to help you...”, (page 31);
- “Instant dry” (page 32);
- “InstantDry Effect - so you feel dry in an instant” (page 33);
- “Instant dry” (page 34);
- “Instant Dry” (page 35);
- “5. Instant Dry effect to help you feel dry in an instant” (page 36);
- “NEW InstantDry™ Effect” (page 37);
- “InstantDry™” (pages 38, 39, 40 and 42);
- “InstantDry” (page 41).

23. Turning first to the goods, in its submissions, the opponent describes its trade as being “particularly in relation to sanitary towels, pads and napkins”, whereas in its submissions, the applicant states that if there has been genuine use at all, it has only been in relation to “sanitary napkins for feminine hygiene.” In relation to the goods, I note that the various screen shots describe the goods as “pads”, “sanitary napkins” and “sanitary towels”. In my view, the competing terms used by the parties to describe the goods are simply alternative ways of describing the same product, and to that extent there is, in my view, very little between the parties. As to the words “for feminine hygiene” mentioned by the applicant, these words appear at the beginning of the opponent’s specification and the correctness of their inclusion is borne out by various references contained in the evidence, for example, “feminine protection” (page 8), “on your period” (page 19), “dry and secure during your period” (page 30), “Feminine Care” (page 32), “Have a happy period” (page 34) and “you will need during your period” (page 36).

24. There has, however, been no use shown in relation to “tampons”, “panty liners”, “sanitary briefs” and “interlabial pads” and I note the opponent does not claim as much. These named goods constitute, in my view, different categories of goods to those upon which any use may have been made. Consequently, if the earlier trade mark satisfies the other aspects of the proof of use assessment, and as any goods upon which genuine use may have been made are all for feminine hygiene and would be described by the average consumer as either sanitary towels, sanitary napkins or sanitary pads, any surviving specification should be limited to “sanitary napkins for feminine hygiene”.

25. Turning now to the trade mark which has been used, in its submissions the opponent acknowledges “that other trade marks also appear in connection with the goods, such as ALWAYS...”. It goes on to refer to the decision of the CJEU in *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, in which the court found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot

be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

26. As I mentioned earlier, the opponent concludes:

"9...The use of InstantDry shown quite clearly shows the mark InstantDry has its own independent character as a mark and serves to indicate origin. Minimum use can of course qualify as genuine use and the opponent has shown proof of use not only in the United Kingdom but in other countries of the European Union...The evidence filed is not mere token use and shows that the opponent was maintaining an outlet for the goods on the relevant market."

27. As the summary above shows, the opponent has used InstantDry in, inter alia, the form in which it stands registered in the European Union both within and after the relevant period and that this trade mark is consistently used with, inter alia, the trade mark "always". However, as the decision in *Colloseum* indicates, that is not an impediment if it will, nonetheless, be understood as an indication of the origin of the goods at issue. In reaching a conclusion, I must not lose sight of the applicant's submission to the effect that the use the opponent has made of its InstantDry trade mark:

"do not make it appear that the sign InstantDry has been used in a manner which could give the public a clear indication that the sign is being used as a trade mark with the aim of distinguishing products from those of other companies, and hence InstantDry does not appear to be used in a trade mark sense".

28. Insofar as the relevant period is concerned, the trade mark InstantDry has been used accompanied by the letters TM or TM (to indicate it is to be regarded as a trade mark) in the Benelux and Ireland (pages 1, 2 and 13) and on other occasions it has

been used in the form in which it stands registered (without an indication that it is to be regarded as a trade mark) i.e. in the United Kingdom, France and Germany (pages 8, 9, 10, 15, 17 and 18). The nature of the use from 2015 i.e. after the relevant period is much the same, although it is, I think, fair to say that the use of the trade mark as registered (with and without the use of TM and TM) is more prevalent.

29. There are also the other uses I have described above many of which are unlikely, in my view, to be considered use as a trade mark; for example: “Instant Dry” pages 4, 5, 6 and 7, page 11 “Instant Dry effect to help you feel dry in an instant”, page 12 “New InstantDry Effect So you feel dry in an instant”, pages 16 and 19, “InstantDry Effect so you feel dry in an instant”, page 30 “including a new instant dry effect...”, page 31 “Instant Dry effect to help you...”, pages 32 and 34 “Instant dry”, page 35, “Instant Dry” and page 36 “Instant Dry effect to help you feel dry in an instant”. Whilst I accept that the opponent has used its trade mark in a range of formats, a number of which are, as I mentioned above, unlikely, in my view, to be taken as indications of trade origin, for reasons which will shortly become apparent, I intend to proceed on the basis that when considered overall, there has been sufficient use, just, of InstantDry which is likely, on the balance of probabilities, to have communicated a trade mark message to the average consumer of the goods at issue.

30. The evidence shows that the trade mark has been used in relation to goods sold by, for example, household names such as Boots and Lloyds Pharmacy in the United Kingdom and Tesco in Ireland. However, the opponent has not provided (even) estimates of the number of goods sold or turnover achieved under the trade mark nor has it provided any indication of the amount spent on promoting the trade mark. Those are extremely surprising and, in my view, important omissions from the factual matrix. In my view, their absence engages the following concerns expressed by the Appointed Persons in the cases mentioned:

Awareness Limited:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public” (my emphasis).

Dosenbach-Ochsner AG:

“22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use” (my emphasis).

31. I have, on the basis of the evidence provided, been able to reach conclusions on the form in which the opponent’s trade mark has been used and in relation to which goods a trade has been conducted. I am, of course, aware that in *Awareness Limited* the Appointed Person made it clear that it was “not strictly necessary to exhibit any particular kind of documentation” to establish genuine use of a trade mark and in *New Yorker*, the GC made it clear that: “an accumulation of items of evidence may allow the necessary facts to be established, even though each of these items of evidence taken individually would be insufficient to constitute proof of the accuracy of those facts”. I also note that the opponent has argued that “minimum use can of course qualify as genuine use” and that “the evidence filed is not mere token use”. However, without at least an estimate of the scale of the opponent’s use i.e. in terms of either quantity of goods sold or turnover achieved in at least some of the jurisdictions in which it trades, and absent any information on the amounts spent promoting the trade mark, I am simply not in a position, on the basis of the evidence provided, to conclude that the opponent has made genuine use of its InstantDry trade mark within the European Union during the relevant period. As a consequence of that conclusion, the opposition falls at the first hurdle and is dismissed accordingly.

Conclusion

32. The opposition has failed because the opponent has not, on the basis of the evidence provided, established genuine use of its InstantDry trade mark in the European Union within the relevant period.

Costs

33. As the applicant has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the applicant on the following basis:

Preparing a statement and considering the opponent’s statement:	£200
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Considering and commenting on the opponent’s evidence:	£300
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Total:

£500

34. I order The Procter & Gamble Company to pay to SCA Hygiene Products AB the sum of **£500**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful. As mentioned in paragraph 5 above, before any final decision is implemented, the TMR will need to ensure that the administrative action mentioned has been completed and the specification of the IR limited accordingly.

Dated this 17th day of December 2015

C J BOWEN
For the Registrar
The Comptroller-General